

Serial No.: 09/812,074
Filing Date: March 19, 2001

REMARKS

Claims 13 and 39 are pending in this application. Claim 1 has been canceled as being directed to a non-elected invention. Claim 13 is amended as discussed below. Claim 39 is amended for clarity.

Claim Objections

Claim 13 has been amended to remove dependency from canceled claim 7 thus addressing the Examiner's objection.

Claim rejections- 35 U.S.C. §112 – second paragraph

The Examiner rejected claim 13, and 39 dependent thereon, under 35 U.S.C. §112 second paragraph as being ambiguous for depending from a canceled claim. Claim 13 has been amended to remove dependency from canceled claim 7, thus addressing this rejection.

Claim rejections- 35 U.S.C. §112 – first paragraph

The Examiner rejected claim 13, and 39 dependent thereon, under 35 U.S.C. §112 first paragraph for failing to comply with the written description requirement.

The claims as amended comply with the written description requirement. Amended claim 13 now recites a method of isolating from a sample a nucleic acid molecule encoding an inward rectifier, G-protein activated, potassium channel which comprises isolating nucleic acids from the sample and contacting the isolated nucleic acids with a nucleic acid probe of at least 15 nucleotides under conditions permitting formation of a complex between the nucleic acid molecule encoding an inward rectifier G-protein activated potassium channel. The nucleic acid probe must also be capable of specifically hybridizing with the nucleic acid sequence of SEQ ID

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NO:1 or complement thereof. The nucleic acid molecule encoding the inward rectifier G-protein activated potassium channel is then separated from the complex. Thus, amended claim 13 contains the additional limitation that the claimed *nucleic acid* probe is capable of specifically hybridizing with the nucleic acid sequence of SEQ ID NO:1 or complement thereof.

The specification sets forth the sequence identified as SEQ ID NO:1 as well as the conditions under which it can be determine if a probe will specifically hybridize to this sequence. See for example, the specification at page 9, lines 21-31; page 12, line 21, through page 13, line 9; and page 13, line 31, through page 14, line 16. As such, the claims as amended recite subject matter which one of skill in the art would recognize as being in the possession of the Applicant at the time of filing. Applicant respectfully requests withdrawal of the rejection.

Priority

As set forth in the discussion regarding written description set forth above, the application satisfies the requirements under 35 U.S.C. §112 first paragraph. The instant application is a continuation of USSN 09/042,494, filed March 16, 1998, now U.S. Patent No. 6,255,459, which is a continuation of USSN 08/066,371, filed May 21, 1993, now U.S. patent 5,747,278. The instant application has the same disclosure as the priority documents and is therefore entitled to the earliest priority date of May 21, 1993.

Claim rejections- 35 U.S.C. §102

Jan et al (U.S. Patent No. 5,670,335)

The Examiner rejected claims 13 and 39 under 35 U.S.C. §102(a), (b), and (e) as being anticipated by Jan et al. The present application is entitled to claim a priority date of May 21, 1993. Jan et al. was filed on June 5, 1995 and has the priority date of Aug. 6, 1993. The present application predates the priority date of Jan et al. As such, Jan et al cannot be used as prior art against this application. Applicant respectfully requests withdrawal of the rejection.

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Kubo et al (Nature 1993)

The Examiner rejected claims 13 and 39 under 35 U.S.C. §102(a) and (b) as being anticipated by Kubo et al. As an initial matter, it is not definite which Kubo reference the Examiner is citing. There are two Kubo references published in 1993 cited in the Information Disclosure Statement submitted by the Applicant, neither of which contains a page 85. From the description provided by the Examiner in support of the rejection referencing figures 1 and 4, Applicant believes the Examiner is referring to the Kubo paper entitled "Primary structure and functional expression of rat G-protein-coupled muscarinic potassium channel" published in Nature, volume 364 at pages 802-806. This paper was published August 26, 1993. As discussed above, the present application is entitled to claim a priority date of May 21, 1993. The present application predates the Kubo reference. As such, Kubo cannot be used as prior art against this application. Applicant respectfully requests withdrawal of the rejection.

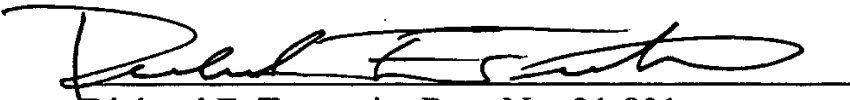
Conclusion

Applicant respectfully submits that the Claims are in condition for allowance. If, upon review, the Examiner feels there are additional outstanding issues, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,
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Dated: November 3, 2004

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